

Inventor : Thurieau *et al.*
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REMARKS

Reconsideration of the instant Office Action, entry of the amendments submitted herewith and allowance of all pending claims are respectfully requested.

In the instant Office Action, claims 1-43 are listed as pending, claims 2-8 and 10-43 are listed as withdrawn from consideration, claim 1 is rejected and claims 9 and 11 are objected to. In response to instant Office Action, Applicants have amended claims 1, 9, 10, 17 and 19. Claims 2-4 and 21 have been canceled, without waiver or prejudice, for being directed to unelected subject matter. Claims 22-29 and 37-43, all of which are directed to compounds according to formula (II), have been canceled, without waiver or prejudice, solely to simplify the application and to limit the issues so as to advance the prosecution of the pending application. Applicants expressly reserve the right to either file a subsequent application directed to the canceled claims or to reintroduce same into the current application in the event that an allowance is not secured by the above-proposed amendments.

Applicants state that the amendments of claims 1, 9, 10, 17 and 19 do not introduce new matter and that the aforementioned amendments do not require any change of inventorship pursuant to 37 C.F.R. 1.48(b).

1. Applicants respectfully file concurrently with this reply a request for continued examination (RCE) under 37 C.F.R. §1.114. Applicants contend that the present request for continued examination (RCE) meets the requirements of 37 C.F.R. §1.114 since prosecution of the pending application on the merits is closed due the finality of the instant Office Action. In compliance with Rule 114, Applicants submit herewith an authorization for the payment of the requisite fee together with this reply to the present Office Action as required under 35 U.S.C. §132. Applicants respectfully request that the finality of the present Office Action be withdrawn pursuant to 37 C.F.R. §1.114 and that the instant submission be entered into the record.

2. Claims 2-8, 10 and 12-30 remain withdrawn from consideration as not being readable on the elected species. In an effort to better restrict the withdrawn claims so as to conform with Applicants' election in response to the restriction requirement as set forth in the Office Action mailed September 29, 2004, claim 1 has been amended to remove the possibility of R¹ and R² being joined together to form a polycyclic ring system. As amended, both R¹ and R² are now monovalent. This amendment required the deletion of subformulae (Ia), (Ib) and

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(Ic), R⁷ and Z⁴ from claim 1. Applicants respectfully contend that withdrawn claims 5-8, 10 and 12-20, all of which fall with the definition of elected invention classified by the Examiner as Group I and are dependent on amended claim 1, do not read on unelected subject matter and as matter of right should be rejoined with pending claims 1, 9 and 11.

Applicants respectfully request the reconsideration withdrawal of claims 5-8, 10 and 12-20. Applicants further respectfully request the full examination of amended claim 1 together with withdrawn claims 5-8, 10 and 12-20.

3. Applicants are grateful for the Examiner's reconsideration and withdrawal of the provisional rejection of claim 1 under 35 U.S.C. 101 as being a duplicate of claim 1 of co-pending U.S. Patent Application 10/333,556.

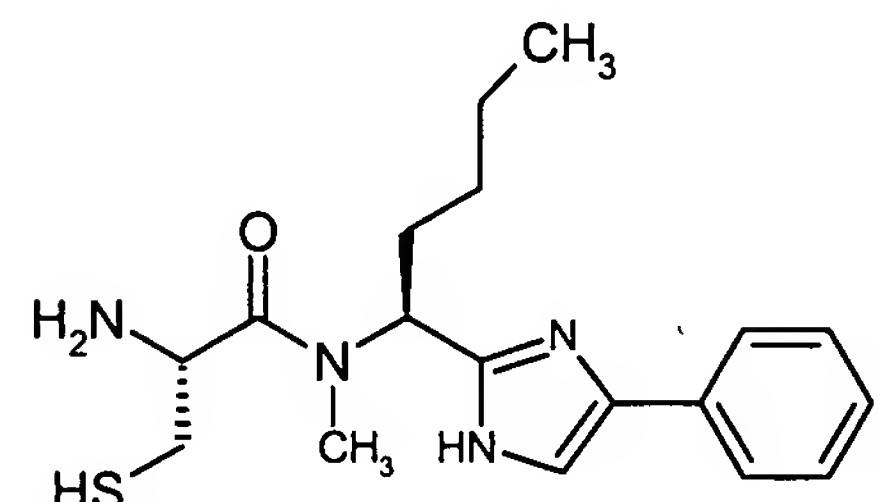
4. Applicants are grateful for the reconsideration and withdrawal of the rejection of claims 1, 9 and 11 under 35 U.S.C. §112, first paragraph, for lack of an enabling disclosure.

5. Applicants are grateful for the reconsideration and withdrawal of the rejection of claims 1, 9 and 11 under 35 U.S.C. §112, second paragraph, for indefiniteness.

6. Applicants are grateful for the reconsideration and withdrawal of the rejection of claim 1 under 35 U.S.C. §102(a) as being anticipated by U.S. 5,733,882 (Carr *et al.*).

7. Applicants are grateful for the reconsideration and withdrawal of the rejection of claim 1 under 35 U.S.C. §102(b) as being anticipated by FR 2.132.632 (Bornowski and Herzig).

8. Claim 1 stands rejected under 35 U.S.C. §102(b) as being anticipated by WO 97/30053 (Gordon *et al.*). In support thereof, the Examiner states Compound 8 found at page 12 of Gordon *et al.*, which has the following structure:



is "embraced by instant claim 1 where R¹ and R⁶ are H; R² is alkyl; R³ is -(CH₂)_m-E-(CH₂)_m-Z², wherein the one 'm' is 2 and the other 'm' is also 2, 'E' is a bond, and Z² is H; R⁴ is -C(=Y)-X² wherein Y is oxygen and X² is substituted alkyl." In an effort to distinguish the instant

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application over the cited prior art, Applicants have amended claim 1 by restricting R³ to the definition found in dependent claim 9, i.e., “R³ is -CH₂-indol-3-yl, -(CH₂)₄-NH-CO-O-t-Bu or -(CH₂)₄-NH₂”. Applicants respectfully note that in “Compound 8” of Gordon *et al.*, a butyl group is in the position equivalent to R³ of claim 1 and as such, does not anticipate, claim 1 as amended.

Applicants note for the Examiner that the restriction of the definition of R³ in claim 1 to the indicated moieties necessitated the deletion of the *proviso* clauses appended to claim 1 which were made irrelevant. In addition, claims 10 and 17 were amended to delete a redundancy created by the amendment of claim 1. Also, claim 19 was amended to delete those moieties lacking antecedent basis due to the restriction of the definition of R³ in claim 1.

Applicants respectfully request the reconsideration and withdrawal the rejection of claim 1 under 35 U.S.C. §102(b) as anticipated by WO 97/30053 (Gordon *et al.*).

9. In the instant Office Action, the Examiner rejected claim 1 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-21 of co-pending U.S. Patent Application Serial No. 10/333,556. Without conceding the correctness of this rejection and in an effort to solely over the provisional rejection of claim 1, Applicants submit a terminal disclaimer in compliance with 37 C.F.R. §1.321(c). Applicants respectfully attest that the alleged conflicting application, U.S.S.N. 10/333,556, and the above-captioned application have been at all times commonly owned by Societe de Conseils de Recherches et d'Applications Scientifiques, S.A.S., as required under 37 C.F.R. §1.130(b) and that said disclaimer meets all the requirements of 37 C.F.R. §3.73(b).

Applicants respectfully request the reconsideration and withdrawal the rejection of claim 1 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-21 of co-pending U.S. Patent Application Serial No. 10/333,556.

10. Applicants are grateful for the Examiner's reconsideration and withdrawal of the objection to the original Abstract as well as the entry thereof into the present application.

11. Applicants are grateful for the acceptance and entry into the record of the Information Disclosure Statement submitted 3 February 2005 and for the Examiner's consideration of the references listed on the PTO-1449 form accompanying said statement. Applicants note that Hungarian Patent HU218 260 B, listed as item “D” on the aforementioned

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PTO-1449 form, is equivalent to European Patent No. 0 253 310, as attested to by Agent Pamela Ball in her submission of 3 February 2005. In an effort to complete the file and to have the cited reference considered, however, Applicants submit herewith a 1st Supplemental Information Disclosure Statement, a completed PTO-1449 form, a copy of the Hungarian patent and a copy of its English language equivalent European Patent 0 253 310 B1. Applicants respectfully request the acceptance and entry of the enclosed documents into the record and the consideration of the cited references.

12. Applicants are grateful for the conditional allowance of claims 9 and 11. Applicants, however, have not amended claims 9 and 11 in independent form including all of the limitations of the base claim and any intervening claims, as directed by the Examiner, in anticipation that base claim 1 has been successfully amended to overcome the rejection thereof. Applicants respectfully request a subsequent opportunity to amend claims 9 and 11, as suggested by the examiner, in response to a later Office Action or if the rejection of claim 1, as amended above, is maintained.

13. Applicants respectfully request, in the event that the Examiner finds that any of claims 1, 9 or 11 are patentable, the rejoinder of withdrawn claims 30-36 since such claims require the use of patentable subject matter. Under the PTO guidelines for restricting claims covering an apparatus and method of using the apparatus, the examiner must show one-way distinctiveness. See MPEP § 806.05(e). That is, either the apparatus or method must be capable of being practiced without the other. As further noted in MPEP § 821.04:

“[I]f Applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined . . . Process claims which depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment if presented prior to final rejection or allowance.”

Applicants submit that Claims 30-36 currently incorporate the limitation of Claim 1 by the language “administering a compound according to claim 1” and that the methods of withdrawn claims 30-36 can only be practiced using the patentable subject matter of claim 1. Applicants respectfully contend that the rejoinder of claims 30-36 is appropriate.

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Applicants submit that in view of the foregoing remarks, claims 1, 5-20 and 30-36 are seen to relate to a single inventive concept, namely derivatives of imidazolyl, and that the claims are in a form and are of the sort that is properly viewed as relating to a single invention that should not be restricted. Applicants respectfully request that the restriction requirement of the Office Action of September 14, 2004 be reconsidered and withdrawn.

CONCLUSION

Applicants submit that each ground for rejection asserted by the Examiner in the instant Office Action has been removed. On this basis, it is submitted that claims 1, 9 and 11 are now in a condition for allowance. Applicants further request the rejoinder of claims 5-8, 10, 12-20 and 30-36 and submit that said claims are also in a condition for allowance.

Prompt and favorable action is solicited.

Should Examiner Tucker deem that any further action be desirable with respect to these matters, she is requested to telephone the Applicants' undersigned representative.

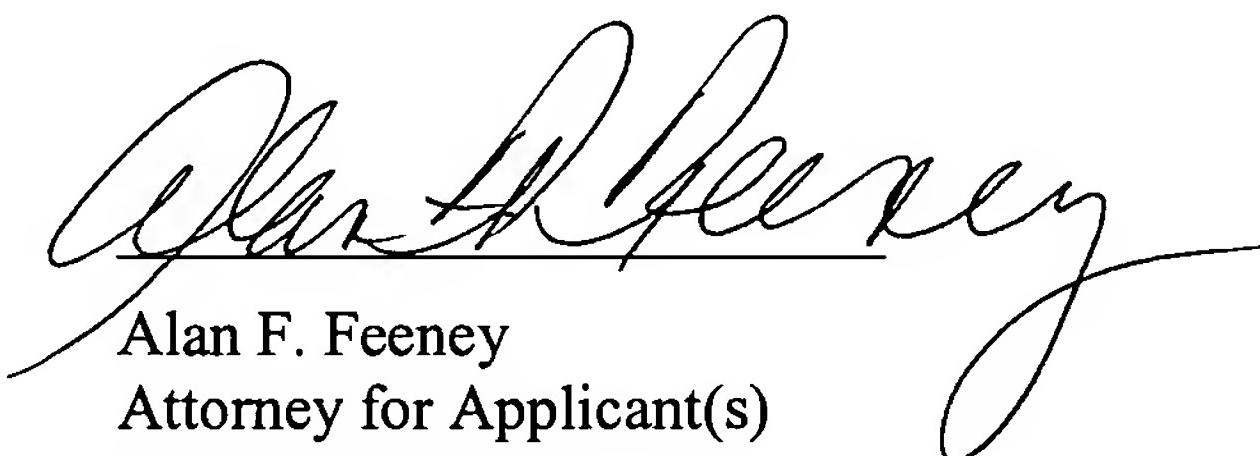
The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-0590.

Respectfully submitted,

Date:

4/5/2006

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